

REMARKS

Claims 1-63 are pending in this application and are currently rejected to by the Examiner. Claims 30-35 and 47 are rejected under 35 USC § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The pending claims are rejected under 35 USC § 103(a) as being unpatentable over various combinations of art, all combinations sharing Prithviraj et al. (U.S. Patent No. 5,987,513, hereinafter "Prithviraj") in view of Adams et al. (U.S. Patent No. 6,185,566, hereinafter "Adams").

Claims 49 and 50 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj-Adams.

Claims 1, 2, 6-11, 24-26, 30-35, 48 and 53-60 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams and further in view of Brim (U.S. Patent No. 5,835,914, hereinafter "Brim").

Claims 3, 4, 27 and 28 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Flack et al. (U.S. Patent No. 6,288,704, hereinafter "Flack").

Claims 5 and 29 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Lamming et al. (U.S. Patent No. 5,862,321, hereinafter "Lamming").

Claims 12, 13, 36 and 37 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Haitani et al. (U.S. Patent No. 5,900,875, hereinafter "Haitani").

Claims 14, 16, 21, 22, 38, 40, 45 and 46 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Vatanen (U.S. Patent No. 6,237,093, hereinafter "Vatanen").

Claims 15 and 39 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, further in view of Vatanen, and further in view of Haitani.

Claims 17 and 41 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Shipley (U.S. Patent No. 5,818,617, hereinafter "Shipley").

Claims 18-20 and 42-44 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Lincke et al. (U.S. Patent No. 6,253,326, hereinafter "Lincke").

Claims 23 and 47 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Scholl et al. (U.S. Patent No. 5,742,762, hereinafter "Scholl").

Claim 51 is rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, and further in view of Flack.

Claim 52 is are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, and further in view of Lamming.

Claim 61 is rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, and further in view of Haitani.

Claim 62 is rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, and further in view of Vatanen.

Claim 63 is rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, and further in view of Shipley.

Objections to claims 12 & 36, 16 & 40, 18 & 42 and 20 & 44

The Examiner objects to **claims 12 & 36, 16 & 40, 18 & 42 and 20 & 44** due to various informalities. Applicants appreciate the Examiner's suggested corrections, and note that none of the corrections narrows the scope of a claim. The suggestions have been accepted, so objections to claims 12 & 36, 16 & 40, 18 & 42 and 20 & 44 should be withdrawn.

Rejection Under 35 U.S.C. § 112 of Claims 30-35 and 47-48

The Examiner rejects **claims 30-35 and 47-48** under 35 U.S.C. § 112 as including terms that have insufficient antecedent basis.

Claims 30, 31, 33, 34 and 35

The Examiner argues that **claims 30, 31, 32, 33, 34 and 35** include terms with insufficient antecedent basis. Without narrowing the claims, "inventory" has been

substituted for "management" to conform to claim 25, from which these claims depend. Therefore, claims 30, 31, 32 33, 34 and 35 should not be rejected under § 112.

Claims 47 & 48

The Examiner argues that **claims 47 & 48** include terms with insufficient antecedent basis. Without narrowing the claims, "scope of network inventory information" has been substituted for "network function" to to claim 25, from which these claims depend. Claim 47 also has been amended with respect to "the updated network information. Therefore, claims 47 & 48 should not be rejected under § 112.

Applicants respectfully submit that the rejection of claims 30-35 and 47-48 under § 112 should be withdrawn.

Rejection Under 35 U.S.C. § 103(a) of Claims 49 and 59

The Examiner rejects **claims 49 and 59** under 35 U.S.C. § 103(a) as unpatentable over Prithviraj et al. (U.S. 5,987,513) in view of Adams et al. (U.S. 6,185,566).

Applicants respectfully submit that claims 49 and 59 should be allowable over Prithviraj-Adams.

Claim 49

Claim 49 includes the limitations:

a palm-sized computer running a browser application;
a synchronization server, in communication with the palm-sized computer;
and
a network management server, in communication with the synchronization server

These limitations are not found in Prithviraj-Adams. In particular, neither a palm-sized computer nor a synchronization server are mentioned by either reference. Combining two references that both lack these features cannot create the missing limitations.

The Examiner uses Prithviraj to argue that reference 180 in Prithviraj is a synchronization server. There is no textual support in Prithvaraj for this view. The descriptions of 140 and 180 are either as a gateway (col. 7, lines 22-64) or a router (col.

13, lines 6-7), but never as a synchronization server for a palm-sized computer. The Examiner admits, however, that Prithviraj does not refer to a palm-sized computer.

The Examiner uses Adams to argue that use of portable (not palm-sized) computers were routinely used for network management. The passage from Adams says:

In most instances 45
where network management functionality is required, larger
computers (e.g., user workstation) have been used to provide
such functionality. This is problematic in networking envi-
ronments where such larger computers are impractical or
unfeasible. For example, in a small to medium sized HVAC 50
(i.e., heating, ventilation and air-conditioning) system, it is
not economically prudent to include a larger computer on the
network with the embedded controller. Thus, for any net-
work management function to be performed, it is conven-
tional for a technician to arrive with a portable computer and 55
attach it to the network, thereby facilitating certain network
management functions.

This passage does not teach or suggest either network management, as opposed to HVAC embedded controller management, and does not teach or suggest using a palm-sized computer. In fact, the suggestion to attach a portable computer directly to the network, at line 55, teaches away from using a synchronization server.

The Examiner further asserts, with passing reference to Xerox's TAB computer (5,862,321) that it would have been obvious to one of ordinary skill in the art to use a palm-sized computer to perform the method taught by Prithviraj. First, Prithviraj does not teach the claimed method. Second, Xerox's TAB did not have nearly enough computing power for one of ordinary skill in the art to substitute it for Prithviraj's computer 160 or 170. See, Roy Want et al. "*The ParcTab Ubiquitous Computing Experiment*" Technical Report CSL-95-1, Xerox Palo Alto Research Center, March 1995 pp. 1-41 (available at <http://sandbox.parc.xerox.com/parctab/csl9501-abstract.html>). Third, just saying so is not enough to prove a *prima facie* case of obviousness for reasons explained below.

To extend a Section 103 rejection beyond the features of the cited references, the Examiner needs to provide evidence of a teaching or suggestion to extend the references to include the claimed features that are admittedly missing. It is

fundamental, as indicated in MPEP § 2143.01, that the Examiner rely on some evidentiary quality suggestion to modify the proposed combination:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

This section of the MPEP cites *In re Lee*, in which the Federal Circuit clarified the need for evidentiary quality support of an Examiner's factual basis for finding a teaching, suggestion or motivation in the prior art (as opposed to the Examiner's opinion), 277 F.3d at 1343-44:

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). ... "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citation omitted] The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). ... In its